

REASONS FOR PRE-APPEAL REQUEST FOR REVIEW

Claims 1, 3, 4, 13, 14, and 17 are pending in this application. Claims 2, 5 – 12, 15 – 16, and 18 – 20 were canceled during prosecution. Claims 1, 3, 4, 13, 14, and 17 were finally rejected in the Office Action mailed 5/28/2008.

Claim Rejections—35 U.S.C. §102(b)

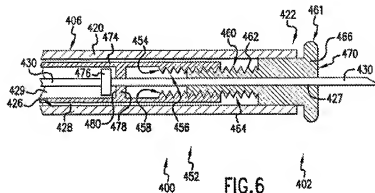
In the Final Office Action mailed 5/28/2008, the Office rejected claims 1, 3, 4, and 17 under 35 U.S.C. § 102(b), alleging the same to be unpatentable over WO 02/11807 to Mickley (hereafter “Mickley”).

Claim 1 and Those Claims Depending Therefrom

Claim 1 is directed towards an injection catheter. The injection catheter comprises a first elongated shaft having a distal end and a proximal end and a first lumen extending therebetween; a needle with a proximal end and distal end and a needle lumen extending therebetween, the needle disposed within the first lumen of the first elongated shaft and extending from a proximal end of the catheter to a distal end of the catheter; a stop collar disposed within the first lumen of the first elongated shaft near the distal end of the needle; a first set of threads located on the needle; and a second set of threads located on the stop collar; wherein rotation of the needle within the first elongated shaft causes longitudinal movement of the stop collar relative to the needle within the first elongated shaft, the positioning of the stop collar within the first elongated shaft

controlling a variable extent to which the needle may be extended beyond the distal end of the first elongated shaft.

Mickley fails to teach every element of claim 1. The Office stated that Mickley discloses “a first set of threads 464” and “a second set of threads 454.” The Office directed Applicants’ attention to FIG. 6 of Mickley, as depicted immediately below:



The Office, however, has ignored the recited positioning of the first and second sets of threads. Claim 1 recites, “a first set of threads located on the needle” and “a second set of threads located on the stop collar.” As seen above in FIG. 6 of Mickley, the first set of threads 464, as labeled by the Office, is *not* located on the needle 430. Rather, threads 464 are located on the helical member 460. And, the second set of threads 454 is *not* located on the stop collar 476, 478, as labeled by the Office. Instead, the threads are “disposed within third lumen 429 of third elongate shaft 474.” (Mickley, page 14, lines 8 – 9).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051,

1053 (Fed. Cir. 1987); MPEP § 2131. Furthermore, “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); MPEP § 2143.01. The Office has failed to consider all the words in claim 1. Because Mickley does not teach or suggest all the elements in claim 1, it is not anticipatory.

Claims 3 – 4 and 17 incorporate all the subject matter of claim 1 and add additional subject matter, making them patentable as well over Mickley. Applicants request that the rejection be withdrawn and that claims 1, 3 – 4, and 17 be allowed.

Claim Rejections—35 U.S.C. § 103(a)

The Office rejected claims 13 – 14 under 35 U.S.C. § 103(a) as being unpatentable over Mickley. As argued above, Mickley fails to teach all the elements of claim 1, from which claims 13 and 14 depend. Whether or not it would have been obvious to one having ordinary skill in the art to make the first elongated shaft of low friction material, as in claim 13, or use polytetrafluoroethylene to make the first elongated shaft, as in claim 14, as asserted by the Office, does nothing to address the lack of disclosure in Mickley. As such, combining Mickley with what the Office asserts would be known to those of ordinary skill does not produce the embodiments of the invention as claimed in claims 13 and 14. To that end, claims 13 and 14 are non-obvious. Applicants request that the rejection be withdrawn.

Conclusion

For at least the reasons presented above, Applicants assert that the subject matter in claims 1, 3, 4, 13, 14, and 17 is patentably distinct over the cited references.

Applicants respectfully request that claims 1, 3, 4, 13, 14, and 17 be allowed.

Respectfully submitted,

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